

REMARKS

Upon entry of the foregoing amendments, claims 1-2, 5, 7, and 13-16 are currently pending in the application. Claims 3, 4, 6, 12 and 17 were previously cancelled without prejudice or disclaimer to the subject matter contained therein. Claims 8-11 and 18 were previously withdrawn as directed to nonelected subject matter. Currently claim 1 is amended to clarify the subject matter contained therein.

The specification has been amended to clarify the common name of certain materials previously only referred to by trade name. In support of these amendments, Applicants concomitantly provide supporting documentation, Appendices A and B, both of which predate the earliest filing date of the application showing that the common names and trade names were known at the time of filing of the application.

The amendment does not introduce any new subject matter within the meaning of 35 U.S.C. §132. Therefore, entry of the amendment is respectfully requested.

Applicants sincerely thank Examiner Brunsman for discussing the case with their representative on several occasions.

SUMMARY OF SPECIES ELECTION REQUIREMENT

In the Action, which is Supplemental to the Action of August 29, 2006, the Examiner has required clarification of the response filed on May 18, 2006.

The Examiner states no antecedent basis for the elected acrylates, specifically in the plural, is found in the application as originally filed. The Examiner states the election must be directed to "a single distinct material or compound".

Further, the Examiner has alleged that the election of "disodium-5-amino-4-hydroxy-3-(phenylazo)naphthalene-2,7-disulfonate" is improper based on an apparent lack of antecedent basis in the specification.

PROVISIONAL ELECTION

Applicant provisionally elects with traverse as the binders aqueous dispersions of acrylates; and as the first pigment a combination of disodium-5-amino-4-hydroxy-3-(phenylazo)naphthalene-2,7-disulfonate (azo pigment) and copper phthalocyanine.

As clarified during calls with the Examiner, support for "aqueous dispersions of acrylates" in the plural form may indeed be found in the as-filed application in claim 3, subsection a), as well as, the last Example in the specification prior to the claims.

Specifically, the aqueous dispersions of acrylates refers to the single distinct material Mowilith® DM 771, which is disclosed throughout the application as originally filed. Further, Applicants have amended the specification to make more obvious the relation between the trade name and the common name. Finally, Applicants submit, as attached in Appendix A, a copy of the brochure entitled "®Mowilith - Dispersionen für den Anstrichssektor" dated 1995. In the brochure, on the last page, it is shown Mowilith® is a polyacrylate.

Furthermore, in relation to disodium-5-amino-4-hydroxy-3-(phenylazo)naphthalene-2,7-disulfonate, Applicants direct the Examiner's attention to the submission, as attached in Appendix B, entitled "Sec. 74.1333 D&C Red No. 33", dated 1999. In the print out, it is shown that D&C Red No. 33 is the disodium salt of 5-amino-4-hydroxy-3-(phenylazo)-2,7-naphthalenedisulphic acid.

Accordingly, Applicants respectfully submit that the elections are proper.

TRAVERSAL

Applicant respectfully traverses the Examiner's requirement for species election.

First, the restriction requirement is traversed because it omits "an appropriate explanation" as to the existence of a "serious burden" if the restriction were not required. See MPEP § 803. Regardless of any differences which may exist between the

inventions set forth in the different groups, a complete and thorough search for the invention set forth in any one of the groups would require searching the art areas appropriate to the other group. Since a search of each the inventions would be coextensive, it would not be a serious burden upon the Examiner to examine all of the claims in this application.

Further at the Examiner's disposal are powerful electronic search engines providing the Examiner with the ability to quickly and easily search all of the claims. Moreover, given the overlapping subject matter, examination of the claims in this application would not pose a serious burden, because the searches would be coextensive in that a search of any one of the invention species.

Finally, Applicant notes that upon allowance of a generic claim, Applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. 1.141.

In view of the foregoing, Applicant respectfully requests the Examiner to reconsider and withdraw the requirement for claim restriction and election of species and examine all claims pending in this application.

S/N 09/840,982

CONCLUSION

If the Examiner has any questions or wishes to discuss this matter, he is welcomed to contact the undersigned attorney.

Respectfully submitted,

NATH & ASSOCIATES PLLC

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NATH & ASSOCIATES PLLC
112 S. West Street
Alexandria, VA 22314
Tel: (703) 548-6284
Fax: (703) 683-8396



Gary M. Nath
Reg. No. 26,965
Tanya E. Harkins
Reg. No. 52,993
Customer No. 20529